

REMARKS

Claims 1-6 are pending in this application. Claims 1 and 3 are independent claims.

By this amendment, claims 1-3 are amended, and new claims 5 and 6 are added.

Reconsideration in view of the above amendments and following remarks is respectfully solicited.

The Claim Objections Are Obviated

The Office Action objects to claim 2 for allegedly failing to further limit the subject matter of a previous claim. This objection is respectfully traversed.

Applicants respectfully submit that claim 2 further specifies the preferable type of patients that would be the recipient of the implantable internal coil system.

Accordingly, withdrawal of the objection to claim 2 is respectfully solicited.

The Claims Satisfy The Requirements Of 35 U.S.C. §112, 2nd Paragraph

The Office Action rejects claim 3 under 35 U.S.C. §112, 2nd paragraph as being indefinite because the examiner alleges that the term "long pulse stimulation" is a relative term which renders the claim indefinite. This rejection is respectfully traversed.

Applicants respectfully point out that in reviewing a claim for compliance with 35 U.S.C. §112, 2nd paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by §112, 2nd paragraph by providing clear warning to others as to what constitutes infringement of the patent. See *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). Applicants respectfully submit that the term "long pulse stimulation" defines a type of stimulation in gastric electrical stimulation and that one skilled in the art would readily recognize such a term. Applicants own specification clearly defines such a "long

pulse stimulation” on at least pages 1-2. It appears that the Examiner is merely looking at the term “long” in isolation without giving full credit to the entire phrase.

As such, Applicants respectfully submit that a person of ordinary skill in the art could easily interpret the metes and bounds of the claim so as to understand how to avoid infringement. Therefore, a rejection under §112, 2nd paragraph is not appropriate.

However, in order to expedite prosecution applicants respectfully submit that the amendment to claim 3 further obviates the rejection of claim 3 under 35 U.S.C. §112, 2nd paragraph.

Accordingly, withdrawal of the rejection of claim 3 under 35 U.S.C. §112, 2nd paragraph is respectfully solicited.

The Claims Satisfy The Requirements Of
35 U.S.C. §101

The Office Action rejects claims 1 and 2 because the claims are allegedly directed to non-statutory subject matter because the structures claimed are in contact with or implanted within the body and such claiming is allegedly amounting to an inferential recitation of the body. This rejection is respectfully traversed.

Applicants respectfully submit that the amendment to claims 1 and 2 obviates the rejection of claims 1 and 2 under 35 U.S.C. §101. Specifically, the amended claim 1 now recites an “implantable” internal coil. As such, applicants respectfully submit that any inferential recitation of the body is now clearly traversed.

Accordingly, withdrawal of the rejection of claims 1 and 2 under 35 U.S.C. §101 is respectfully solicited.

The Claims Define Patentable Subject Matter

The Office Action rejects:

(1) claims 1 and 2 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,879,859 to Boveja (hereafter Boveja); and

(2) claims 1-4 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0123774 to Loeb et al. (hereafter Loeb) in view of Boveja. These rejections are respectfully traversed.

Applicants respectfully submit that Boveja, either alone or in combination with Loeb, fails to teach or suggest each and every feature as set forth in the claimed invention. ...

Rejection under 102(e)

The Examiner alleges that Boveja inherently discloses a device that is capable of being used on gastroparesis patients and can stimulate for extended periods of time and stimulate the stomach via stimulation of an undamaged portion of the vagus nerve. (see Office Action, pages 3-4). Applicants respectfully submit that even if Boveja discloses such features, the above noted features are not what is being claimed in the present invention.

For example, applicants respectfully submit that it appears that the Examiner is confusing the term “long pulse stimulation” with the relative phrase “extended periods of time”. However, Applicants respectfully point out that the term “long pulse stimulation” is understood in the art to designate a stimulation with a frequency close to the intrinsic gastric slow wave frequency (IGF) and with a pulse width of 300ms or more. (see Applicants’ specification, pages 1-2). ...

As such, it goes to follow that the present invention is aimed at providing a gastric electrical stomach stimulation apparatus that uses a pulse generator and an external coil connected thereto to send electricity to an internal coil which is implantable in a patient. In the present invention, the internal coil is connected to a waveform rectifier circuit which is connected to electrodes which are designed to be positioned in contact with a gastric wall. A sine wave current is feed from the pulse generator when the external coil is positioned at an external site in proximity to where the internal coil is implanted so that a long pulse stimulation with a pulse width of 300ms or more is effective on the stomach.

In contrast with the present invention, Boveja merely discloses a system that includes parameters that fall outside of the required parameters for a “long pulse stimulation”. For example,

in Boveja the parameters for the “pulse width” only fall within the range of 0.05 ms to 4.0 ms. (see Boveja, col. 15, lines 13-62). As such, Boveja’s system cannot possibly provide a “long pulse stimulation” to a patient because it fails to include a pulse width of 300ms or more.

Furthermore, Boveja fails to teach or suggest that its system is utilizable for gastroparesis patients whose vagus nerve has been cut, as set forth in claim 2. Instead, Boveja merely discloses that vagus nerve stimulation is done. However, Boveja is completely silent about and discloses absolutely nothing about long pulse stimulation for when a vagus nerve is cut.

For at least the reasons noted above, applicants respectfully submit that Boveja fails to teach or suggest each and every feature as set forth in the claimed invention.

According to MPEP §2131, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ...claims.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). The elements must be arranged as required by the claims, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicants respectfully submit that the Office Action has failed to establish the required *prima facie* case of anticipation because the cited reference, Boveja, fails to teach or suggest each and every feature as set forth in the claimed invention.

Applicants respectfully submit that independent claim 1 is allowable over Boveja for at least the reasons noted above.

As for dependent claim 2, this claim is also allowable for at least the reasons set forth above regarding its corresponding independent claim, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1 and 2 under 35 U.S.C. §102(e) is respectfully solicited.

Rejections under §103

Applicants also respectfully submit that Loeb fails to make up for the deficiencies found in Boveja.

Applicants respectfully submit that neither Loeb nor Boveja, taken singularly or in combination, (assuming these teachings may be combined, which applicants do not admit) teach or suggest a long pulse stimulation with a pulse width of 300ms or more and a system being adaptable for a patient whose vagus nerve has been cut. Loeb offers no specific parameters at all for its system and Boveja's parameters are nowhere near the required pulse width of 300ms or more.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicants respectfully submit that the examiner has failed to establish a *prima facie* case of obviousness at least in part because the examiner has failed to show how each and every feature is taught by the cited art.

Applicants respectfully submit that the combination of cited art fail to teach or suggest each and every feature as set forth in the claimed invention.

Applicants respectfully submit that independent claims 1 and 3 allowable over the combination of Loeb and Boveja for at least the reasons noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1-4 under 35 U.S.C. §103(a) is respectfully requested.

Furthermore, applicants respectfully submit that the additional features that are set forth in new claims 5 and 6 are also allowable.

Conclusion

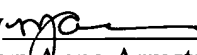
In view of the foregoing, Applicant(s) respectfully submit that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 **to schedule a Personal Interview.**

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

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Respectfully submitted,

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